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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,800

01/17/2006

Richard Farrar

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MAGINOT, MOORE & BECK, LLP

CHASE TOWER

111 MONUMENT CIRCLE

SUITE 3250

INDIANAPOLIS, IN 46204

EXAMINER

WOODALL, NICHOLAS W

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

08/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,800	Applicant(s) FARRAR ET AL.	
	Examiner Nicholas Woodall	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/20/2009 has been entered.

Drawings

2. The drawings were received on 05/20/2009. These drawings are not acceptable because new limitations were added, i.e. the addition of a cutting blade, that are not supported by the disclosure as originally filed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to require the invention to further include a surgical tool for cutting, which is not supported by the

Art Unit: 3775

disclosure as originally filed. The applicant directs the examiner to paragraphs 9, 20, and 26 and original claims 6 and 7 for support of the newly added limitations (see page 2 lines 18-20, page 2 lines 25-27, page 5 lines 14-20, and originally filed claim 6 and claim 7 filed 02/17/2005). The examiner would like to note that the paragraphs of the specification as originally filed as well as claims 6 and 7 as originally filed passively state that the device can be used with a surgical tool, such as a saw blade or a drill bit. However, neither the specification nor the claims as originally filed disclose the invention comprising a kit that includes the guide block in combination with a bone saw and/or a drill bit making the newly added limitations new matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hauri (WIPO Publication WO00/00093).

Hauri discloses a device comprising a guide block, at least one position monitor (17f) for tracking the location of the position indicator to position the guide part relative to a reference point, a signal generator (the computer) connected to the drives to generate positioning signals that are transmitted to the drives to cause movement of the guide part relative to fixation parts of the guide block relative to a reference point, and a surgical tool (12), i.e. a saw blade, having a cutting structure that engages the tool

Art Unit: 3775

engagement surface of the guide part during use of the surgical tool (see Figure 12).

The guide block comprises fixation parts (3, 10a, 10c, etc.) attached to the patient's tissue, a guide part (11) mounted in relation to the fixation parts having a first tool engagement surface (11a) to engage a bone saw, a second tool engagement surface (11b) to engage a drill, at least two drives (5v and 10f) to adjust the position of the guide part relative to the fixation parts in at least two degrees of freedom, wherein the drives include adjusting means, i.e. knobs, accessible outside the housing (see Figure 10), and at least one position indicator (10l) fixed to the fixation parts at a location related to the location of the guide part when attached to the fixation parts. The guide block further includes a housing (10e) in which the drives are located, The guide block further includes connector shafts (for example 10c and 10g) that extend from the fixation parts to the guide part, wherein the connector shafts are moved relative to the fixation parts by the drives to adjust the location of the guide part. The fixation part further includes a plurality of openings (for example 3b, 3c, and 3d) that receive bone screws (4) to fix the device the patient's tissue.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4-6, 8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeOrio (U.S. Patent 5,681,316) in view of Hauri (WO00/00093).

DeOrio discloses a device comprising a guide block. The guide block comprises fixation parts (12, 16, 20, etc.) attached to the patient's tissue, a guide part (26 and 60) mounted in relation to the fixation parts having a tool engagement surface (97) to engage a bone saw, at least three drives (34, 38, 40, and 42) to adjust the position of the guide part relative to the fixation parts in at least three degrees of freedom, wherein the drives include adjusting means, i.e. knobs,. The guide block further includes connector shafts (for example 14 and 58) that extend from the fixation parts to the guide part, wherein the connector shafts are moved relative to the fixation parts by the drives to adjust the location of the guide part. The fixation part further includes an opening (36) that receive a fastener (28) to fix the device the patient's tissue. DeOrio further discloses at least one drive (42) includes a threaded shaft (88) on the guide part, the examiner is interpreting element 60 as part of the guide part and the treaded shaft of the drive is located on the guide part, that is received by a threaded bore (92) on the fixation part, wherein the drive adjusts the medio-lateral angle of the guide part (see column 3 lines 39-42). DeOrio fails to disclose the device further comprising a computer assistance mechanism and a cutting tool. Hauri teaches a device comprising a guide block having drives (5f and 10v), a surgical tool, i.e. a bone saw, and a computer assistance mechanism, wherein the computer assistance includes at least one position monitor (17f), at least one position indicator (10l) attached to the guide block, a signal generator (a computer) connected to motors that operate the drives via a flexible shaft (17a) that imparts rotation motion to the drives from a remote location in order to allow the surgeon to cut the bone of a patient and to allow the surgeon to perform the surgical

Art Unit: 3775

procedure in an extremely precise manner (column 1 lines 4-7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of DeOrio further comprising a surgical tool and a computer assistance mechanism in view of Hauri in order to allow the surgeon to cut the bone of a patient and to allow the surgeon to perform the surgical procedure in an extremely precise manner.

Response to Arguments

9. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection. The applicant's arguments are directed to the previous rejections in view of the new amendments. The examiner has provided new grounds of rejection as necessitated by the amendments.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3775

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775